

Application No. 09/908070
Page 5

Amendment
Attorney Docket No. S63.2B-9826-US01

Remarks

Rejections

35 U.S.C. §112

Claim 4 is rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly calim the subject matter which applicant regards as the invention. The Office Action asserts that there is insufficient antecedent basis for the limitation "said hydrophilic dye" in line 1.

Claim 4 has been amended to depend from new claim 39. Support for the new claim is found on page 3 of the specification.

35 U.S.C.

Claims 1, 3, 4, 5 and 6 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,667,840 to Tingey et al.

Claim 1 has been amended to incorporate specific classes of fluorescent agents. Support is found on page 7 of the specification and from claim 3 as originally filed.

Tingey et al. do not suggest the specific dyes found in claim 1 as amended.

At col. 4, lines 56-61, Tingey et al. disclose only the specific coumarin fluorescing agents, coumarin 481 (7-diethylamino-4-trifluoromethyl-2H-1-benzopyran-2-one) and coumarin 485 (7-dimethylamino-4-trifluoromethyl-2H-1-benzopyran-2-one), for use therein.

These are neither xanthenes nor triarylmethanes as found in claim 1 as amended.

Further to claims 3 and 4, the Office Action asserts on page 3 that Tingey et al. disclose that the fluorescing agent is a fluorescein, triarylmethane, rhodamine, a derivative thereof, and mixtures thereof (col. 3, lines 56-61) and that the hydrophilic dys is 5-carboxyfluorescein, b-carboxyfluorescein, fluorexon, lissamine green, indocyanine green, rose bengal or mixture thereof (col. 4 line 56 to col. 5, line 16).

We disagree.

Tingey et al. do not disclose the use of fluorescein, rhodamine or triarylmethane fluorescing agents or any of their derivatives thereof.

At col. 3, lines 56-61, Tingey et al. only but only generally discuss fluorescent agents generally.

Application No. 09/908070
Page 6

Amendment
Attorney Docket No. S63.2B-9826-US01

At col. 4, lines 56 to col. 5, line 16, Tingey et al. suggest only coumarin 481 and coumarin 485 as discussed above.

Furthermore, Tingey et al. teach at col., lines 35, that in order for the fluorescing agents to be effective in their application, they must be soluble in the polydimethylsiloxane, and Tingey et al. state that in fact, most fluorescing agents are virtually insoluble in polydimethylsiloxane. Thus, as to claim 4, it would be expected that the hydrophilic dyes would in fact, be insoluble in the hydrophobic polydimethylsiloxane.

Consequently, claim 1 as amended is not anticipated by Tingey et al. for at least the reasons discussed above. Claims 3, 4, 5 and 6 depend from claim 1 and are not anticipated for at least the reasons that claim 1 is not anticipated by Tingey et al. Applicants therefore respectfully request withdrawal of the rejection of claims 1, 3, 4, 5 and 6 under 35 U.S.C. §102(b) as being anticipated by Tingey et al. (US 5667840).

35 U.S.C. §103(a)

Claim 7 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Tingey et al. '840 in view of U.S. Patent NO. 6,254,634 to Anderson et al.

The Office Action asserts that Tingey et al. disclose the claimed invention except for the use of a lubricant in combination with a crosslinkable silicone, but that Anderson teaches that an intermediate layer of crosslinkable silicone is provided with a coating in order to improve the performance or durability of the coating (col. 3, lines 41-62 and col. 5, lines 42-64), and that it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the method of Tingey et al. with the crosslinkable silicone in order to improve the durability of the coating on the medical device.

Claim 1 has been amended and is patentable over Tingey et al. for at least the reasons discussed above. Combining the crosslinkable silicone of Anderson et al. with the method of Tingey et al., does not lead one of skill in the art to claim 1 as amended.

Claim 7 depends from claim 1 and is patentable for at least the reasons that claim 1 is patentable.

Applicants respectfully request withdrawal of the rejection of claim 7 under 35 U.S.C. §103(a) as being obvious over Tingey et al. '840 in view of Anderson et al. (US

Application No. 09/908070
Page 7

Amendment
Attorney Docket No. S63.2B-9826-US01

6254634).

Claims 8-11 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Tingey et al. '840 in view of U.S. Patent NO. 5,266,359 to Spielvogel.

The Office Action asserts that Tingey discloses the claimed invention except for the mixture further comprising a surfactant, but that Spielvogel teaches that a surfactant may be added to a medical device in order to improve the lubriciousness of the device (col. 2, lines 49-56 and col. 4, lines 38-52), and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Tingey et al. with the surfactant of Spielvogel in order to improve the lubricity of the device.

Tingey et al. has been discussed above.

Claim 1 is patentable over Tingey et al. for at least the reasons discussed above. Combining the surfactant of Spielvogel with the method of Tingey et al. does not lead one of skill in the art to the invention of claim 1.

Claims 8-11 depend from claim 1 and are patentable for at least the reasons that claim 1 is patentable. Applicants respectfully request withdrawal of the rejection of claims 8-11 under 35 U.S.C. §103(a) as being obvious over Tingey et al. '840 in view of Spielvogel (5266359).

Allowable Subject Matter

Claims 12-14 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 12 has been rewritten in independent form.

New claims 40-42 have been added. Support for claim 40 is found on page 3 of the specification. Support for claim 41 and 42 is found on page 3 of the specification. Applicants believe these claims to be patentably distinct over Tingey et al.

Application No. 09/908070
Page 8

Amendment
Attorney Docket No. S63.2B-9826-US01

CONCLUSION

Claims 1, 4-14 and 39-42 are pending in the application. Applicants have addressed each of the issues presented in the Office Action. Applicants respectfully request reconsideration and an early allowance of the claims as presented.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date:

April 16, 2004

By:

Lisa R. Lindquist
Lisa R. Lindquist
Registration No.: 43071

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9185
Telephone: (952) 563-3000
Facsimile: (952) 563-3001

f:\wpwork\lrl\09826us01_amd_20040415.doc